

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain
Serial No. 10/693,539
Filed: 10/24/2003

Examiner: Kim, Wesley Leo
Art Unit: 2617

For: **CALL TRANSFER FOR AN INTEGRATED WIRELINE AND WIRELESS
SERVICE USING A TEMPORARY DIRECTORY NUMBER**

Mail Stop Appeal Brief – Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant also encloses a payment in the amount of \$1520.00 as required by 37 C.F.R. § 1.17(c) to cover the fees associated with this appeal brief and a Three-month Extension of Time and requests that this be considered a petition therefor. If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of record, i.e., Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-40 were rejected with the rejection made final on March 28, 2006.

Claims 1-40 are pending and are the subject of this appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of Appellant's knowledge.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a communication environment where calls are established with a single mobile terminal through either a wireless network or the public switched telephone network (PSTN) via a terminal adaptor, which is capable of wirelessly communicating with the mobile terminal. As such, the mobile terminal may facilitate traditional cellular calls via the wireless network, or traditional PSTN calls via the terminal adaptor (Specification, paragraph 0005). The terminal adaptor and mobile terminal communicate via a local wireless interface, and as such, communications via the PSTN through the terminal adaptor are only possible within a limited communication zone supported by the terminal adaptor. When the mobile terminal is involved in a call and within the communication zone of the terminal adaptor, calls are facilitated via the wireless interface with the terminal adaptor. *Ibid.* As the mobile terminal approaches the outer limits of the communication zone, the terminal adaptor will detect a decrease in its ability to facilitate effective communications with the mobile terminal and trigger the supporting telephony switch to effectively transfer the call to the mobile terminal through the wireless network, as well as register with the wireless network, if registration has not already taken place. *Ibid.* Preferably, the mobile terminal is associated with a primary directory number that is associated with the PSTN. A temporary directory number for the mobile terminal is provided by the wireless network and is used for facilitating incoming calls, outgoing calls, and service transitions between the PSTN and wireless network. *Ibid.*

The mobile terminal will simply answer the new incoming call made to the temporary directory number associated with the mobile terminal when served by the wireless network. This effects a transition from the PSTN connection to the wireless connection (Specification, paragraph 0006). The terminal adaptor may interact with the supporting telephony switch to assist in establishing the call, as well as effecting the transition. *Ibid.*

In particular, claim 1 recites a system according to the present invention comprising:

- a) a wireline network interface (such as telephone line(s) interface 42, Figure 3; see Specification, paragraph 0041);
- b) a local wireless interface (such as local wireless interface 40, Figure 3; Specification, paragraph 0041) providing a communication zone (see terminal adaptor zone 24, Figure 1; Specification, paragraph 0020) in which communications with a mobile terminal (such as mobile terminal 12, Figure 1) are possible, the mobile terminal associated with a primary

directory number and adapted to communicate with the local wireless interface to facilitate a call through a wireline network (such as PSTN 22, Figure 1) and communicate with a wireless network (such as cellular network 20, Figure 1) to facilitate a call through the wireless network (Specification, paragraphs 0005, 0015, and 0016); and

c) a control system (such as control system 38, Figure 3) cooperating with the wireline network interface and the local wireless interface and adapted to:

i) establish through the wireline network a first call involving the mobile terminal by communicating with the wireline network via the wireline network interface and communicating with the mobile terminal via the local wireless interface (Specification, paragraphs 0005, 0016-0017, and 0029; see Figure 2A);

ii) during the first call, detect the mobile terminal moving out of the communication zone (Specification, paragraphs 0005, 0017, 0026, 0029, 0033, and 0035; see Figure 2B, step 136); and

iii) initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number (Specification, paragraphs 0006, 0017, 0026, and 0035-0038; see Figures 2B and 2C) .

Claim 22 is similar to claim 1, but written in method format. Claim 22 recites a method of handling calls involving a mobile terminal (such as mobile terminal 12, Figure 1) adapted to communicate with a local wireless interface (such as local wireless interface 40, Figure 3; Specification, paragraph 0041) to facilitate a call through a wireline network (such as PSTN 22, Figure 1) and communicate with a wireless network (such as cellular network 20, Figure 1) to facilitate a call through the wireless network, the method comprising:

a) establishing through the wireline network a first call involving the mobile terminal by communicating with the wireline network via a wireline network interface (such as telephone line(s) interface 42, Figure 3; see Specification, paragraph 0041) and communicating with the mobile terminal via the local wireless interface (Specification, paragraphs 0005, 0016-0017, and 0029; see Figure 2A);

b) during the first call, detecting the mobile terminal moving out of a communication zone (see terminal adaptor zone 24, Figure 1; Specification, paragraph 0020) associated with the

local wireless interface (Specification, paragraphs 0005, 0017, 0026, 0029, 0033, and 0035; see Figure 2B, step 136); and

c) initiating a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number (Specification, paragraphs 0006, 0017, 0026, and 0035-0038; see Figures 2B and 2C).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Claims 1-5, 8-17, 21-35, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,154,650 to Abidi et al. (hereinafter “Abidi”) in view of U.S. Patent No. 5,260,988 to Schellinger et al. (hereinafter “Schellinger”).

B. Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of U.S. Patent Application Publication No. 2002/0106028 to Thyssen (hereinafter “Thyssen”).

C. Claims 7, 20, and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of U.S. Patent No. 6,445,921 to Bell (hereinafter “Bell”).

D. Claims 18, 19, 36, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of U.S. Patent Application Publication No. 2004/0132485 to Charney et al. (hereinafter “Charney”).

E. Claim 39 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of U.S. Patent No. 5,722,068 to Bartle et al. (hereinafter “Bartle”).

(7) ARGUMENT

A. Introduction

The Patent Office has failed to establish *prima facie* obviousness. The claims of the present invention recite initiating a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network **using a temporary directory number**. In particular, the Patent Office has admitted Abidi does not teach this element, but asserts that Schellinger discloses this element. However, nothing in Schellinger, alone or in

combination with any of the other cited references, cures the deficiency of Abidi. In particular, Schellinger discloses that a cordless base station performs a handoff from the cordless system to the cellular telephone system by producing a three way call between the portable device, the calling party, and the user's cellular phone number. The user's cellular phone number is used in the three way call. Schellinger specifies that the cellular phone number is a normal directory number (see Schellinger, col. 6, lines 10-30). Thus, the cellular phone number is not, under any reasonable interpretation, a temporary directory number. Thus, Schellinger's three way call does not disclose using a temporary directory number to initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network, as recited in the claims. Therefore, the references, alone or in combination, fail to teach or suggest the temporary directory number of the claimed invention.

Even if any of the references disclosed each of the elements in the claims, a point which Appellant does not concede, there is no motivation to combine the teachings in each of the references. The Examiner has failed to provide evidentiary support for his statements that it would have been obvious to use the respective tertiary references because of the stated motivation. It is not appropriate for the Examiner to reach conclusions based on his own understanding or experience, or based on his opinion of what would be basic knowledge, without evidentiary support.

Because the Examiner has failed to provide actual evidence to support the stated motivations to combine the various tertiary references, the motivations are improper. Because the references, alone or in combination, do not teach each and every element of the claimed invention, the combinations do not establish obviousness. For these reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the application in light of the deficiencies of the combinations of references.

B. Summary of the References

1. U.S. Patent No. 6,154,650 to Abidi

Abidi is directed to a combination mobile station and wireline cordless base station, each having a different directory number. When the mobile station is within radio range of the wireline cordless base station, it retunes its operating frequency to that of the wireline cordless

base station. The wireline cordless base station notifies the wireless network of its wireline directory number when it senses the mobile station is within range. When the wireless network receives a call for the mobile station, it forwards the call to the wireline cordless base station over the wireline network. When the mobile station moves out of range of the wireline cordless base station, the mobile station returns to the operating frequency of the wireless network, and the wireline cordless base station notifies the wireless network that it is no longer receiving calls for that mobile station (Abidi, Abstract).

2. U.S. Patent No. 5,260,988 to Schellinger

Schellinger is directed to a dual mode portable telephone that may receive calls in both cordless and cellular telephone systems (Schellinger, col. 1, lines 6-9). When the dual mode device is in cellular mode, the radio channel associated with the cordless base station is sampled for a predetermined time. When a signal on the sampled cordless base station is detected, the portable phone moves to the cordless mode and remains in the cordless mode as long as the signal quality exceeds a predetermined value (Schellinger, Abstract).

Schellinger discloses that a cordless base station performs a handoff from the cordless system to the cellular telephone system by producing a three way call between the portable device, the calling party, and the user's cellular phone number (Schellinger, col. 8, lines 29-34 and lines 44-48). The user's cellular phone number is used in the three way call. Schellinger specifies that the cellular phone number is a normal directory number, and is not a temporary directory number (see Schellinger, col. 6, lines 10-30).

3. U.S. Patent Application Publication No. 2002/0106028 to Thyssen

Thyssen relates to the reduction of quantization noise in digital signal compression (Thyssen, paragraph 0002). The system of Thyssen uses the signal previously quantized with a sample-by-sample quantization techniques to determine an expected quantization distortion. The expected quantization distortion is determined for each of a plurality of frames of the signal. The expected quantization signal is then removed from each of the frames of the signal (Thyssen, Abstract).

4. U.S. Patent No. 6,445,921 to Bell

Bell is directed to a dual mode cellular and cordless telephone and a method for semi-automatic handover of calls between the two modes, wherein dropped calls are re-established by the telephone without data from the base stations or networks (Bell, col. 1, lines 5-11).

5. U.S. Patent Application Publication No. 2004/0132485 to Charney

Charney relates to a cordless telephone system capable of modular expansion of its features and capabilities through the addition of wireless peripherals (Charney, paragraph 0002). The cordless handset and one or more expansion units communicate with a cordless base station via communication channels in a wireless communication protocol (Charney, Abstract). The expansion units provide the system with interfaces to various external networks, such as an additional analog telephone line, a digital telephone line, or a cellular telephone. Conference calling functionality is provided between the handset and the expansion units within the primary base units (Charney, Abstract).

6. U.S. Patent No. 5,722,068 to Bartle

Bartle is directed to a method for notifying a digital cell phone user of an imminent disconnection (Bartle, Abstract). The method analyzes condition indicators such as continuous count and rate indications of frame checksum errors, insufficient quality frames, symbol and chip errors, output power levels, received signal strength, soft handoff status, other pilot signal indication, and current pilot strength indication (Bartle, Abstract). When these conditions indicate a disconnection is imminent, the quality of the received communication signal is enhanced when possible, and the user is notified of the imminent disconnection (Bartle, Abstract).

C. Legal Standards for Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the

differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. Initially, the Patent Office must show that there is a suggestion to combine the references. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template. *In re Fine*, 837 F.3d 1071 (Fed. Cir. 1988). To reconstruct the invention by such selective extraction constitutes impermissible hindsight. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991). The “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight.” *Ibid*.

The Federal Circuit notes

that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . **The range of sources available, however, does not diminish the requirement for actual evidence.** That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.”

Ibid (emphasis added and internal citations omitted).

After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03.

While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with

the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

D. Claims 1-5, 8-17, 21-35, and 40 Are Non-Obvious Because the Combination of Abidi and Schellinger Does Not Teach or Suggest Using a Temporary Directory Number

The present invention relates to a communication environment where calls are established with a single mobile terminal through either a wireless network or the public switched telephone network (PSTN) via a terminal adaptor, which is capable of wirelessly communicating with the mobile terminal. As such, the mobile terminal may facilitate traditional cellular calls via the wireless network, or traditional PSTN calls via the terminal adaptor (Specification, paragraph 0005). The terminal adaptor and mobile terminal communicate via a local wireless interface, and as such, communications via the PSTN through the terminal adaptor are only possible within a limited communication zone supported by the terminal adaptor. When the mobile terminal is involved in a call and within the communication zone of the terminal adaptor, calls are facilitated via the wireless interface with the terminal adaptor. *Ibid.* As the mobile terminal approaches the outer limits of the communication zone, the terminal adaptor will detect a decrease in its ability to facilitate effective communications with the mobile terminal and trigger the supporting telephony switch to effectively transfer the call to the mobile terminal through the wireless network, as well as register with the wireless network, if registration has not already taken place. *Ibid.* Preferably, the mobile terminal is associated with a primary directory number that is associated with the PSTN. A temporary directory number for the mobile terminal is provided by the wireless network and is used for facilitating incoming calls, outgoing calls, and service transitions between the PSTN and wireless network. *Ibid.*

In particular, both independent claims 1 and 22 recite “using a temporary directory number” to initiate a transition of a call connected to the mobile terminal through the wireline network to the call being connected to the mobile terminal through the wireless network. A temporary directory number is contrasted from a primary directory number of the PSTN in paragraph 0005 of the specification as filed. The Patent Office admits that Abidi does not teach initiating a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number (see Office Action mailed March 28, 2006, p. 7). The Patent Office relies on Schellinger to supply the missing element. *Id.* Specifically, the Patent Office asserts that Schellinger, col. 8, lines 29-34 and col. 8, lines 44-48 teach the temporary directory number. The Patent Office explains “the cellular leg of the 3 way call is the temporary directory number. . .” *Id.*

However, a close examination of Schellinger reveals that Schellinger also fails to teach the recited claim element. Schellinger, col. 8, lines 29-34 states in full:

. . . block 725. At block 725, the PCC 101 operating in a cordless telephone system requests that the cordless base station 115 perform a handoff from the cordless to cellular telephone system 103 by producing a three way call between the PCC 101, the other party and the user's cellular phone number.

The passage does indicate that there is a three way call, but indicates that the user's cellular phone number is used in the three way call. Earlier, Schellinger specifies that the cellular phone number is a normal directory number (see Schellinger, col. 6, lines 10-30). Thus, under any reasonable interpretation, the cellular phone number is not a temporary directory number. Thus, this passage and its three way call does not indicate that the combination teaches a temporary directory number as recited in the claims.

Schellinger, col. 8, lines 44-48 states in full:

. . . remains in the call in the cordless telephone system. In FIG. 7-2 the PCC 101 answers the cellular leg of the three way call at block 727 to open communication between the PCC 101 operating in the cellular telephone system 103 and the other party. Thus, the PCC 101. . . .

Again, while the passage does indicate that there is a three way call, and that there is a cellular leg, the earlier passage confirms that the user's cellular number is used to make the cellular leg.

Since the cellular number is not a temporary number, the three way call does not teach the temporary number recited in the claims.

In the Final Office Action, the Patent Office states that the landline number of Schellinger is the primary directory number of the claims and that the cellular directory number of Schellinger is the claimed temporary directory number (Final Office Action mailed March 28, 2006, p. 2). The Patent Office adds that the cellular phone number is a temporary number used to connect the mobile phone to the cellular phone system, temporary meaning that the cellular directory phone is used only when it travels outside the range of the cheaper and more reliable cordless region. *Id.* This interpretation ignores the teachings of Schellinger, as well as the plain meaning of the claim language and the Specification of the present invention.

First of all, if the Patent Office is reading the cellular phone number of Schellinger as the temporary directory number and the landline phone number as the primary directory number, then Schellinger does not teach “the mobile terminal associated with a primary directory number” as claimed in claim 1 since the landline phone number of Schellinger used in the three way call is associated with the cordless base unit and not the mobile terminal (Schellinger, col. 6, lines 26-46; col. 7, lines 59-65). The Patent Office’s interpretation ignores the fact that Schellinger teaches using the landline phone number of the cordless base unit as part of the three way call and not a primary directory number associated with the mobile terminal. Therefore, under the Patent Office’s interpretation, Schellinger does not teach or suggest “the mobile terminal associated with a primary directory number” as claimed in claim 1. Therefore, claim 1 is allowable.

In addition, Schellinger teaches that the user is available via both a cellular and a landline number and that the PCC 101 determines whether the user’s cellular or landline number has call routing priority (Schellinger, col. 6, lines 10-21). Much of the specification of Schellinger following the passage above discusses both situations, i.e., where the user’s cellular number has call routing priority, and where the user’s landline number has call routing priority. It is clear from a reading of Schellinger in its entirety that these are considered equal options. This contradicts the Patent Office’s assertion that the cellular phone number is a temporary number used to connect the mobile phone to the cellular phone system, temporary meaning that the cellular directory phone is used only when it travels outside the range of the cheaper and more reliable cordless region. First of all, Schellinger shows that the cellular phone number is not

used only when it travels outside the cordless region (e.g., the user can have calls routed to the cellular phone number first before transferring to a second system if the PCC is not located, see Schellinger, col. 6, lines 10-21). Second, it is also clear that Schellinger does not contemplate the cellular number to be used any less often than the landline number. (See Figs. 6-1, 6-2, 7-1, and 7-2 and col. 7, line 7 through col. 8, line 61). Therefore, the cellular number of Schellinger is no more “temporary” than the landline number of Schellinger. The interpretation that the cellular number of Schellinger is somehow “temporary” is not supported by the teachings of Schellinger itself. Third, Schellinger plainly contemplates that the cellular phone number is a number assigned by the cellular provider (Schellinger, col. 1, lines 28-32). A number assigned by the cellular provider is different than a temporary directory number. The assigned directory number of the cellular phone in Schellinger stays the same for every call. In contrast, the temporary directory number of the claimed invention changes from call to call based on the location of the mobile terminal. Thus, Schellinger’s cellular phone number cannot be the temporary directory number of the claim. Reading the cellular number of Schellinger to be the claimed temporary directory number is therefore contrary to the teachings of the Schellinger reference.

In addition, the plain meaning of the claim language is that a temporary directory number is used for the purpose of initiating a transfer of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network. The Specification as filed teaches that a temporary directory number is contrasted from a primary directory number of the PSTN (Specification, paragraph 0005). The temporary directory number of the present invention is assigned by the wireless switch or VLR when the mobile terminal is registering with the cellular access network and is obtained to initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network (Specification, paragraphs 0029-0031 and 0035-0037). In contrast, the cellular phone number of Schellinger is assigned by the cellular provider and is not assigned by the wireless switch or VLR when the mobile terminal is registering with the cellular access network in order to initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network.

Thus, the plain meaning of the claims read in light of the Specification compels a finding that the cellular number of Schellinger is not the same as the claimed temporary directory number. Schellinger does not teach or suggest a control system adapted to “initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number” as claimed in claim 1. Since Schellinger does not teach or suggest the element for which it is cited, and the Examiner has admitted Abidi does not teach this element, the combination does not teach or suggest each and every element, and therefore does not render claim 1 obvious.

In short, the references individually do not teach or suggest the temporary directory number recited in claim 1. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every claim element, claim 1 is allowable.

Claims 2-5, 8-17, and 21 depend from claim 1 and are not obvious for at least the same reasons. Claims 23-35 and 40 depend from claim 22 and also are not obvious for at least the same reasons.

E. Claim 6 Is Non-Obvious over the Combination of Abidi, Schellinger, and Thyssen

Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over Abidi and Schellinger in further view of Thyssen. Applicant respectfully traverses. For the Patent Office to combine references in an obviousness determination, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Originally, the Patent Office asserted the motivation to combine Thyssen is “to provide a method of transmitting data over the internet and bypass the charges associated with a typical phone call.” (Office Action of October 17, 2005, p. 8). This asserted motivation lacks the evidence required by the Federal Circuit. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is

improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness.

In the Final Office Action, the Patent Office responded to Appellant's above stated argument that the asserted motivation to combine Thyssen with Abidi and Schellinger by stating that "it is well known in the art that a wireline network interface is a voice over packet interface as recited in Thyssen and to the examiner, one skilled in the art, it is obvious that the implementation of a voice over packet interface further reduces costs of use by bypassing the charges associated with a typical landline phone call." (Final Office Action mailed March 28, 2006, p. 3). The Patent Office seems to rely on the Examiner's opinion as one of ordinary skill in the art. However, the Federal Circuit in *Dembiczak* noted

that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved . . . **The range of sources available, however, does not diminish the requirement for actual evidence.** That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added and internal citations omitted).

Appellant still submits that the Patent Office has failed to provide any actual evidence that supports the stated motivation, as required by *Dembiczak*. Even if the motivation comes from the knowledge of one of ordinary skill in the art, actual evidence to support the stated motivation must be provided. The Patent Office has failed to provide such actual evidence and instead just makes a conclusion based on the opinion of the Examiner, which is exactly the sort of broad conclusory statement that the Federal Circuit found not to be evidence in *Dembiczak*. In addition, a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01; see also *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (the level of skill in the art cannot be relied upon to provide the suggestion to combine references). Moreover, it is not appropriate for the Examiner to reach conclusions based on his own understanding or experience, or based on his opinion of what would be basic knowledge, without evidentiary support. MPEP 2144.03 (it is not appropriate for an examiner to rely solely on "common knowledge" in the art without some evidentiary support). Since the Patent Office

here relies only upon the opinion of the Examiner that it would have been obvious to combine Thyssen without any actual evidence in support, Appellant respectfully submits that the Patent Office is impermissibly using hindsight reconstruction in an effort to combine the references to reach the claimed invention. Since the Patent Office has not supplied the requisite actual evidence to support the stated motivation, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness.

Applicant further traverses the rejection because the combination does not show the temporary directory number as recited in independent claim 1. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Thyssen that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every claim element, claim 6 is allowable.

F. Claims 7, 20, and 38 Are Non-Obvious Over the Combination of Abidi, Schellinger, and Bell

Claims 7, 20, and 38 were rejected under 35 U.S.C. § 103 as being unpatentable over Abidi in view of Schellinger and in further view of Bell. Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine the references is “to provide wireless communications to a user” or “to provide a low cost method of short range wireless voice and data links between devices.” (Final Office Action mailed August 25, 2006, p. 13). These asserted motivations lack the evidence required by the Federal Circuit. Since the motivations lack the required evidence, the motivations are improper. Since the motivations are improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness.

In the Final Office Action, the Patent Office responded to Appellant’s above stated argument that the asserted motivation to combine Bell with Abidi and Schellinger by stating that

“it is well known in the art that a local wireless interface is adapted to support communication with a mobile terminal using Bluetooth technology, and to the examiner, one skilled in the art, the local wireless interface adapted to support communication with a mobile terminal using Bluetooth technology provides a low cost method of short range wireless voice and data links between devices.” (Final Office Action mailed August 25, 2006, p. 4). Once again, as with claim 6 above, the Patent Office seems to rely on the Examiner’s opinion as one of ordinary skill in the art. However, as discussed above, even if the motivation comes from the knowledge of one of ordinary skill in the art, actual evidence to support the stated motivation must be provided. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Patent Office failed to provide the required actual evidence to support the stated motivation to combine Bell with Abidi and Schellinger. Instead, the Patent Office just makes a conclusion based on the opinion of the Examiner, which is exactly the sort of broad conclusory statement that the Federal Circuit found not to be evidence in *Dembiczak*. In addition, a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01. Moreover, it is not appropriate for an examiner to rely on “common knowledge” in the art without some evidentiary support. See MPEP § 2144.03. Since the Patent Office here relies only upon the opinion of the Examiner that it would have been obvious to combine Bell without any actual evidence in support, Appellant respectfully submits that the Patent Office is impermissibly using hindsight reconstruction in an effort to combine the references to reach the claimed invention. Since the Patent Office has not supplied the requisite actual evidence to support the stated motivation, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness.

Applicant further traverses the rejection because the combination does not show the temporary directory number as recited in independent claims 1 and 22. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Bell that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every claim element, claims 7, 20, and 38 are allowable.

G. Claims 18, 19, 36, and 37 Are Non-Obvious Over the Combination of Abidi, Schellinger, and Charney

Claims 18, 19, 36, and 37 were rejected under 35 U.S.C. § 103 as being unpatentable over Abidi and Schellinger in further view of Charney et al. (hereinafter “Charney”). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Appellant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts the motivation is “to provide a method of supporting simultaneous communications via a plurality of communication channels within the cordless telephone system.” (Final Office Action mailed August 28, 2006, p. 14). This asserted motivation lacks the evidence required by the Federal Circuit. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness.

In the Final Office Action, the Patent Office responded to Appellant’s above stated argument that the asserted motivation to combine Charney with Abidi and Schellinger by stating that “it is well known in the art that a local wireless interface can be based on a 802.11 standard and to the examiner, one skilled in the art, it is obvious to provide a method of supporting simultaneous communications via a plurality of communication channels within the cordless telephone system.” (Final Office Action mailed August 25, 2006, pp. 4-5). Once again, the Patent Office seems to rely on the Examiner’s opinion as one of ordinary skill in the art. However, as discussed above, even if the motivation comes from the knowledge of one of ordinary skill in the art, actual evidence to support the stated motivation must be provided. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Patent Office failed to provide the required actual evidence to support the stated motivation to combine Charney with Abidi and Schellinger. Instead, the Patent Office just makes a conclusion based on the opinion of the Examiner, which is exactly the sort of broad conclusory statement that the Federal Circuit found not to be evidence in *Dembiczak*. In addition, a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01. Moreover, it is not appropriate for an examiner to rely on “common knowledge” in the art without some evidentiary support. *See*

MPEP § 2144.03. Since the Patent Office here relies only upon the opinion of the Examiner that it would have been obvious to combine Charney without any actual evidence in support, Appellant respectfully submits that the Patent Office is impermissibly using hindsight reconstruction in an effort to combine the references to reach the claimed invention. Since the Patent Office has not supplied the requisite actual evidence to support the stated motivation, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the Patent Office has not established obviousness.

Appellant further traverses the rejection because the combination does not show the temporary directory number as recited in independent claims 1 and 22. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Charney that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every claim element, claims 18, 19, 36, and 37 are allowable.

H. Claim 39 Is Non-Obvious Over the Combination of Abidi, Schellinger, and Bartle

Claim 39 was rejected under 35 U.S.C. § 103 as being unpatentable over Abidi and Schellinger in further view of Bartle et al. (hereinafter “Bartle”). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Even if Bartle is properly combined with Abidi and Schellinger, the combination does not teach each and every element of claim 39. Claim 39 depends from claim 22 and contains all of the limitations of claim 22. As explained above, Abidi and Schellinger do not teach or suggest the use of a temporary directory number, as claimed in claim 22. The Patent Office points to nothing in Bartle that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every claim element, claim 39 is allowable.

I. Conclusion

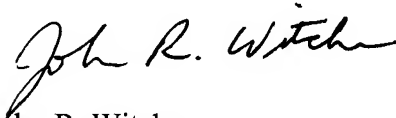
The Patent Office has failed to establish *prima facie* obviousness. The claims of the present invention recite initiating a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network **using a temporary directory number**. The combination of Abidi and Schellinger does not teach or suggest using a temporary directory number as recited in the claimed invention. In particular, the Patent Office has admitted Abidi does not teach this element, but asserts that Schellinger discloses this element. However, Schellinger discloses that a cordless base station performs a handoff from the cordless system to the cellular telephone system by producing a three way call between the portable device, the calling party, and the user's cellular phone number. The user's cellular phone number used in the three way call of Schellinger is a normal directory number, and thus is not a temporary directory number. Therefore, the references, alone or in combination, fail to teach or suggest the temporary directory number of the claimed invention.

In addition, there is no motivation to combine the teachings in each of the references. The Examiner has failed to provide evidentiary support for his statements that it would have been obvious to use the respective tertiary references because of the stated motivation. It is not appropriate for the Examiner to reach conclusions based on his own understanding or experience, or based on his opinion of what would be basic knowledge, without evidentiary support. Because the Examiner has failed to provide actual evidence to support the stated motivations to combine the various tertiary references, the motivations are improper. Because the references, alone or in combination, do not teach each and every element of the claimed invention, the combinations do not establish obviousness. For these reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow all pending claims.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

A handwritten signature in cursive script, appearing to read "John R. Witcher".

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(8) APPENDIX

1. A system comprising:
 - a) a wireline network interface;
 - b) a local wireless interface providing a communication zone in which communications with a mobile terminal are possible, the mobile terminal associated with a primary directory number and adapted to communicate with the local wireless interface to facilitate a call through a wireline network and communicate with a wireless network to facilitate a call through the wireless network; and
 - c) a control system cooperating with the wireline network interface and the local wireless interface and adapted to:
 - i) establish through the wireline network a first call involving the mobile terminal by communicating with the wireline network via the wireline network interface and communicating with the mobile terminal via the local wireless interface;
 - ii) during the first call, detect the mobile terminal moving out of the communication zone; and
 - iii) initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number.
2. The system of claim 1 wherein the mobile terminal is registered with the wireless network while the first call is established.
3. The system of claim 1 wherein the control system is further adapted to request the temporary directory number from the wireline network.
4. The system of claim 1 wherein the transition is initiated by sending a message configured to initiate establishing a wireless network connection to the mobile terminal through the wireless network using the temporary directory number associated with the mobile terminal; connecting the first call to the wireless network connection, and dropping a wireline network connection with the mobile terminal.

5. The system of claim 1 wherein the wireline network interface is a traditional telephony line interface.
6. The system of claim 1 wherein the wireline network interface is a voice over packet interface.
7. The system of claim 1 wherein the wireless network is one of the group consisting of TDM, CDMA, and OFDM.
8. The system of claim 1 wherein the transition is initiated by sending a message intended for a wireline switch and configured to cause the wireline switch to transfer the first call to the mobile terminal through the wireless network using the temporary directory number.
9. The system of claim 1 wherein the transition is initiated by sending a message intended for a wireline switch and configured to cause the wireline switch to establish a three-way call based on the first call to the mobile terminal through the wireless network using the temporary directory number.
10. The system of claim 9 wherein the control system is further adapted to send a second message intended for the wireline switch and configured to instruct the wireline switch to drop a wireline network connection.
11. The system of claim 1 wherein the mobile terminal is also associated with a wireline network directory number, such that incoming calls for the mobile terminal directed to the wireline network directory number are established via the wireline network and incoming calls for the mobile terminal directed to the temporary directory number are established via the wireless network.

12. The system of claim 1 wherein the control system includes a signal processing function adapted to provide any necessary conversion of signals between the wireline network interface and the local wireless interface.

13. The system of claim 1 wherein the control system is adapted to detect the mobile terminal moving out of the communication zone by detecting a bit error rate associated with communications with the mobile terminal via the local wireless interface surpassing a defined threshold.

14. The system of claim 1 wherein the control system is adapted to detect the mobile terminal moving out of the communication zone by detecting a degradation in quality associated with communications with the mobile terminal via the local wireless interface surpassing a defined threshold.

15. The system of claim 1 wherein the control system is adapted to detect the mobile terminal moving out of the communication zone by detecting an inability to communicate with the mobile terminal via the local wireless interface.

16. The system of claim 1 wherein the control system is adapted to detect the mobile terminal moving out of the communication zone by detecting a decrease in signal strength associated with communications with the mobile terminal via the local wireless interface surpassing a defined threshold.

17. The system of claim 1 wherein the local wireless interface is adapted to support communications with the mobile terminal using cordless telephone technology.

18. The system of claim 1 wherein the local wireless interface is adapted to support communications with the mobile terminal using wireless local area network telephone technology.

19. The system of claim 18 wherein the wireless local area network technology is based on 802.11 standards.

20. The system of claim 1 wherein the local wireless interface is adapted to support communications with the mobile terminal using Bluetooth technology.

21. The system of claim 1 wherein the control system is further adapted to detect a signal from the mobile terminal and initiate the transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network, the signal from the mobile terminal responsive to a user of the mobile terminal requesting the transition.

22. A method of handling calls involving a mobile terminal adapted to communicate with a local wireless interface to facilitate a call through a wireline network and communicate with a wireless network to facilitate a call through the wireless network, the method comprising:

- a) establishing through the wireline network a first call involving the mobile terminal by communicating with the wireline network via a wireline network interface and communicating with the mobile terminal via the local wireless interface;
- b) during the first call, detecting the mobile terminal moving out of a communication zone associated with the local wireless interface; and
- c) initiating a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number.

23. The method of claim 22 wherein the mobile terminal is registered with the wireless network while the first call is established.

24. The method of claim 22 wherein the control system is further adapted to request the temporary directory number from the wireline network.

25. The method of claim 22 wherein initiating the transition comprises sending a message configured to initiate establishing a wireless network connection to the mobile terminal through the wireless network using the temporary directory number associated with the mobile terminal; connecting the first call to the wireless network connection, and dropping a wireline network connection with the mobile terminal.

26. The method of claim 22 wherein initiating the transition comprises sending a message intended for a wireline switch and configured to cause the wireline switch to transfer the first call to the mobile terminal through the wireless network using the temporary directory number.

27. The method of claim 22 wherein initiating the transition comprises sending a message intended for a wireline switch and configured to cause the wireline switch to establish a three-way call based on the first call to the mobile terminal through the wireless network using the temporary directory number.

28. The method of claim 27 further comprising sending a second message intended for the wireline switch and configured to instruct the wireline switch to drop a wireline network connection.

29. The method of claim 22 wherein the mobile terminal is also associated with a primary network directory number, such that incoming calls for the mobile terminal directed to the primary directory number are established via the wireline network and incoming calls for the mobile terminal directed to the temporary directory number are established via the wireless network.

30. The method of claim 22 further comprising providing any necessary conversion of signals between the wireline network interface and the local wireless interface.

31. The method of claim 22 further comprising detecting the mobile terminal moving out of the communication zone by detecting a bit error rate associated with communications with the mobile terminal via the local wireless interface surpassing a defined threshold.

32. The method of claim 22 further comprising detecting the mobile terminal moving out of the communication zone by detecting a degradation in quality associated with communications with the mobile terminal via the local wireless interface surpassing a defined threshold.

33. The method of claim 22 further comprising detecting the mobile terminal moving out of the communication zone by detecting an inability to communicate with the mobile terminal via the local wireless interface.

34. The method of claim 22 further comprising detecting the mobile terminal moving out of the communication zone by detecting a decrease in signal strength associated with communications with the mobile terminal via the local wireless interface surpassing a defined threshold.

35. The method of claim 22 wherein the local wireless interface supports communications with the mobile terminal using cordless telephone technology.

36. The method of claim 22 wherein the local wireless interface supports communications with the mobile terminal using wireless local area network technology.

37. The method of claim 36 wherein the wireless local area network technology is based on 802.11 standards.

38. The method of claim 22 wherein the local wireless interface supports communications with the mobile terminal using Bluetooth technology.

39. The method of claim 22 further comprising inserting a signal into a voice path for the first call prior to initiating the transition to warn parties to the first call of a transfer.

40. The method of claim 22 further comprising detecting a signal from the mobile terminal and initiating the transition of the first call being connected to the mobile terminal through the

wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network, the signal from the mobile terminal responsive to a user of the mobile terminal requesting the transition.

(9) EVIDENCE APPENDIX

Appellant relies on no evidence, thus this appendix is not applicable.

(10) RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, this appendix is not applicable.